REMARKS

The present invention provides an efficiency in permitting a personal response to a user of a website such as an electronic catalog with online products, who is making a specific inquiry relative to, for example, products that are displayed. A responder individual, who is employed on behalf of the electronic catalog company, can be provided additional resources as a result of the present invention to enable an efficient and precise response to any inquiry from the potential customer.

The responder, operating from his/her terminal, will have displayed on a screen specific information as a result of the execution of an algorithm as defined, for example in the processing steps and unit in the inquiry processing apparatus of the present invention.

Specifically to avoid wasted and expensive labor time and to improve the capability of being responsive in an intelligent manner to a potential customer, our present invention permits the recording of a history of the provision of viewed content pages by the customer to the specific browser terminal. This data history includes providing page information indicating content pages having been previously provided by the browser terminal and further, establishing a hierarchical level to enable a ranking system with regards to the previously provided content pages.

Thus, when the user enters into an inquiry page via the browser terminal and asks specific information, our invention is capable of judging, in an automatic manner, what level in the hierarchical ranking of content pages have been previously provided, with this information displayed at the responding terminal so that the responder will have the result of the judgment and the page information along with the inquiry from the user.

As can be determined, to enable an efficient use of an algorithm, the recording history of past content pages from that specific browser can be stored and subject to the execution of the algorithm and a judging step and a providing step is executed to provide information to the responding terminal display.

The previous Office Action relied upon the *Hanai et al.* Patent Publication No. 2001/0051893 for use in an e-commerce website wherein a user can make purchases and those purchases can be recorded and stored. When a user would sign in to a log in screen, for example for the purpose of identification and authentication, the sales history of that user could be reviewed and based on that sales history, a recommendation or a sales pitch for other related items (not the previously purchased items) can then be presented or proposed to the user.

The Final Office Action withdrew a rejection based on the *Hanai et al.* patent publication and is now relying upon the *Hirayama* (U.S. Patent No. 4,124,172) to anticipate Claims 11 and 13 of the present application. In order to meet the requirements of 35 U.S.C. §1.116, applicants have cancelled Claims 11-13 to narrow the issues in consideration by the Examiner.

The Office Action further rejected the remaining Claims 1-2, 5-10 and 12 under 35 U.S.C. §103 over the *Hirayama* patent, when taken further in view of the previously cited *Fushimi et al.* (U.S. Patent Publication No. 2004/0148232).

The *Hirayama* reference is specifically directed to protecting a user by using an intermediate relaying computer so that the user is capable of an anonymous browsing through the intermediary of an inquiring button management computer. See Figure 1, Element 410. The user is disclosed with a terminal 200 while the catalog provider of content is disclosed as item 300. Various modifications of this system are set forth in two other embodiments.

The core teaching of *Hirayama*, however, is to prohibit personal information from being revealed, for example to the purveyors of the electronic catalog presenting apparatus. That is, the user will be anonymous unless he/she specifically agrees to be revealed.

With regards to our claims and hypothetically assuming that the electronic catalog presenting apparatus presents information on products, the user must make a connection through the intermediary inquiry button management computer and is assigned a unique ID not revealed to the electronic catalog provider. Thus, the user is capable of browsing anonymously through an electronic catalog. The only identification to the electronic catalog provider, as to the user, would be an arbitrary ID assigned by the intermediate management computer 410 in Figure 1. See Column 10, Lines 48-55.

The electronic catalog provider can insert on a web page a "CALL ME" button 315 to enable a user to inquire about detailed information of a product. See Column 5, Lines 59-67. At that point, an input screen under the control of the intermediate management computer can provide a window for inputting an IP address of the user, buttons for selecting a type of inquiry, and additionally a control window for setting forth conditions associated with the inquiry. See Column 6, Lines 5-11.

The user then can decide whether this input data can be transmitted from the management computer 410 to the web page carrying computer 310. As noted in Column 6, the customer request management computer 320 can extract information for responding to the received inquiry from stored catalog data and can transmit a response again through the management computer 420. If the inquiry cannot be handled automatically, the management computer 320 can attempt to provide or detect a responder person suitable for handling an inquiry of a particular user, and

can notify that person at the electronic catalog provider. An option is provided for communication either by direct telephone or IP address.

As can be seen, any history relating to an inquiry content is only stored in the management computer 420 as shown in Figure 3. See Column 7, Lines 52-62.

As can be readily determined, however, any possible claim of a teaching of storing information relative to the previously browsed pages, is not maintained by either the intermediary inquiry button management computer 410, nor the customer request management computer 310 at the electronic catalog provider. Thus, only the IP address management computer 420 at the intermediary service provider creates a stored table history as shown in Figure 3, and only after the CALL ME button has been executed.

Thus, no information can be previously accumulated in "a recording step" in the electronic catalog presenting apparatus, nor in fact is there any history stored in the intermediary IP address management computer 420 until the user actually decides to make an inquiry with the CALL ME button. Thus, there is no capability for a judging step or judging unit wherein the previous browsed content pages, that had been reviewed prior to execution of the CALL ME button, could be recorded in the electronic catalog presenting apparatus. The ability to provide a more efficient presentation to a responder's terminal with a history of browser pages and a ranking of such pages on a hierarchical level is not contemplated nor taught, nor even possible.

In fact, to maintain an anonymous browsing by the user, a different customer ID for each inquiry from the same user could be generated for each contact, and the data stored in the IP address management computer is further erased, as set forth in Column 8, Lines 36-42, as follows:

Note that, in the present embodiment, the IP address management computer 420 will impart a different customer number to an inquiry from the same user if the occurrence is different.

Further, the data stored in the IP address management computer 420 is suitably erased.

As can be appreciated, even if the electronic catalog presenting apparatus, in hindsight from the teachings of our present invention, attempted to utilize a computer program to hypothetically realize the savings in time and efficiency of our present invention, <u>it would not be possible</u>. Thus, the *Hirayama* reference actually teaches away from our present invention which has long been recognized as an indicia of non-obviousness.

> [I]t is generally settled that the change in prior art device which makes the device inoperable for its intended purpose cannot be considered to be an obvious change.
>
> *Hughes Aircraft Co. v. United States*, 215 U.S.P.Q. 787, (Ct.Cl. Trial Div. 1982)
>
> * * *
>
> "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, <u>or would be led in a direction divergent from the path that was taken by the applicant</u>."
> *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994); *see KSR*, 127 S. Ct. at 1739-40 (explaining that when the prior art teaches away from a combination, that combination is more likely to be nonobvious). Additionally, a reference may teach away from a use when that use would render the result inoperable. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001). (underline added)
>
> In re Icon Health and Fitness, Inc. 2007 U.S. App. Lexis 18244, *10.

As can be seen in Column 9, Lines 11-24 of *Hirayama*, limited information is provided from the IP address management computer 420 consisting of product name and inquiry along with the arbitrarily set ID information to the customer request management computer 320.

Thus, the same problem of having to determine the level of knowledge and the correct amount of information to be provided to such a user through the ID number, would still create the same inefficiencies sought to be resolved by our present invention.

The second embodiment is similar to that of the first embodiment except that it discloses in Figure 5 a telephone number instead of the IP address, to enable an immediate connection. Again, as can be appreciated, the advantages of knowing the previous browsing history before the inquiry is submitted and having the capacity to provide that information with a suggestion as to the page that could be utilized or could not be utilized and as is realized in our present invention, is not possible in the *Hirayama* disclosure.

The telephone number management computer 430 will again utilize a different customer number to an inquiry from the same user on a subsequent occasion and will erase the data stored as set forth in Column 11, Lines 23-27.

> Note that the telephone number management computer 430 will impart a different customer number to an inquiry from the same user if the occurrence is different.

> Further, the data stored in the telephone number management computer 430 is suitably erased.

Finally, the third embodiment as shown in Figure 6, specifically addressed another possible problem in ensuring the anonymous browsing by the user. That is, the electronic catalog presenting apparatus could be sophisticated enough to provide "statistical processing" to accordingly attempt to secure information as to a specific user. In this regard, the IP address management computer 420, unlike the first and second embodiments, can sequentially store the inquiry information. Note, it is inquiry information that is stored, not a full history of the browsing of the user before he/she exercises the CALL ME button. This storage, however, is not for the purposes of enabling the electronic catalog presenting apparatus to exercise a recording

step of recording a history of the provision of content pages to the browser terminal, nor is it for purposes of enabling a judging step of judging when an inquiry is received and ranking, on a hierarchy level, the content pages that have been browsed. Certainly it is not for providing any result of a judgment of the prior use and the level or hierarchy ranking of previous pages to the responding terminal of the electronic catalog presenting apparatus.

Rather, this recording of specific inquiries with the exercise of the CALL ME button, is to enable the IP address management computer to maintain a unique and different customer number so that statistical processing cannot be utilized or performed to secure background information as to the particular customer.

Thus, the advantages of the *Hirayama* reference is for protecting an anonymous browsing by a user with control in the user, not in the electronic catalog presenting apparatus.

Our present invention is to improve the performance of the electronic catalog presenting apparatus and the efficiency of a person manning a responder terminal for each inquiry based upon a history of the provision of content pages and the capacity of automatically judging and ranking a hierarchical level of content page to a responding terminal.

Even in this third embodiment, any history that is recorded, not at the electronic catalog presenting apparatus, but rather at the IP address management computer 420, is also obscured by different identification numbers and by a periodic erasing of the inquiry information as set forth in Column 12, Line 65 through Column 13, Line 5.

> Further, by doing this, since a different identification number is notified to the information providing company every time even for inquiries from the same customer, the action of identifying the personal information of the user by linking them, etc. can be prevented.

> Note that, even if the inquiry information from the user is stored in this way, preferably it is sequentially erased and updated every certain period. (underline added)

In summary, the principal reference relied upon for the rejection of our current claims teaches away from the advantages of our present information and as part of the cost of providing a user with the capability of an anonymous browsing, it is not designed to facilitate efficiencies and money saving features for the electronic catalog presenting apparatus. At most, the third embodiment stores and keeps for a limited time period, the inquiry information and the times of the inquiry information. It does not catalog nor record the actual browsing pages that the user may have reviewed anonymously before it exercises the CALL ME button to make an inquiry.

In the third embodiment, there is even a desire to prevent any statistical processing that might provide such background information to the electronic catalog presenting apparatus.

The Office Action relied upon the *Fushimi et al.* reference for purportedly being in the same field of endeavor and capable of providing a judging step when an inquiry is received as to whether the content page of a predetermined hierarchy level had been previously provided.

The Office Action attempted to phase this language to be similar to our previous claim language. However, as set forth on Page 6, in actuality the cited judging unit is only associated with a catalog aggregator 3 that simply was capable of judging the catalog provider who provided the catalog data for making a determination whether a selected product catalog could be provided or not. Citing Paragraph [0115] and Figure 12, Element S189.

> [0115] Upon receiving the catalog data, the catalog aggregator 3 judges the catalog provider who provided this catalog data (step S107). Here, the catalog provider device group 1 may provide an identification information of the catalog provider along with the catalog data in order to make it easier for the catalog aggregator 3 to judge the catalog provider who provided the catalog data, or the catalog provider may be judged by some other method.

As can be readily appreciated, this is not directed to the user and inquiries, nor any history of browser pages from a specific user. *Fushimi et al.* simply discloses a catalog aggregator which searches a catalog for missing information. When missing information is detected, a contact provider is then contacted automatically to provide the missing information. See Paragraph [0127]. Thus, the catalog aggregator makes a request to the content provider to provide missing information. There is no analogous teaching or suggestion about a user making an inquiry through an inquiry page. The only inquiring through an inquiry page is the CALL ME button associated with the *Hirayama* disclosure. Additionally, the *Fushimi et al.* reference would not teach a recording unit configured to record a history of the past provision of content pages that were provided to a browser terminal.

Actually, *Fushimi et al.* only would disclose a computer readable program code for causing the computer to function as an electronic catalog aggregating apparatus. See Paragraph [0012].

Neither the *Hirayama* nor the *Fushimi et al.* teach alone or in combination, a recording unit for recording a user's specific browsing history and storing it to enable a judging step to judge whether a content page of a lowest hierarchical content has been previously provided to the browsing terminal. Certainly there is no teaching or suggestion of providing any page containing the received inquiry and the result of the judgment to a responder's terminal to improve the efficiency of responding to such an inquiry.

Applicant respectfully submits that the present invention as defined by the current claims more than adequately distinguishes over any combination of references and that the applicant has more than adequately disclosed specific claimed elements that are neither suggested nor taught

nor capable of even being realized in any hypothetical combination of the *Hirayama* and *Fushimi et al.* publications.

> It is the Examiner's burden to establish *prima facie* obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) Obviousness requires a suggestion of all the elements in a claim *(CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Here, we find that the Examiner has not identified all the elements of claim 1, nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention.
>
> *Ex parte* Karoleen B. Alexander, No. 2007-2698, slip op. at 6 (B.P.A.I. Nov. 30, 2007)   (Copy Enclosed)

In summary, our present invention is to provide efficiencies and cost saving features to the electronic catalog provider and ultimately more efficient services to an inquirer who has browsed through the web pages. In such an event, an electronic catalog is generally composed of web pages that can be hierarchically organized in the order of a large catalog, medium catalog, small catalog, and individual products, for example.

Our present invention is based upon an assumption that a customer (user) of a browser terminal having browsed pages of a lower hierarchy level would intrinsically have more knowledge of specific products. Therefore, based upon a recording of this history, we provide a judgment unit or a judgment processing step to research this recorded history of browsed pages, and determine the lowest hierarchy level as a strong indicator for presuming the extent of a customer's knowledge of the products, to thereby as a preliminary step before presenting the inquiry from such a user, to process and provide the individual at the responding terminal on his or her display, a ranking or lowest hierarchical level along with the specific inquiry, to thereby create efficiencies.

The *Fushimi et al.* reference simply converts a plurality of pieces of electronic catalog data specified by a catalog user into one electronic catalog, teaches a catalog aggregator for securing the title or for securing a source of catalog data. It certainly does not teach a storing of history, of browsing, nor judging whether any content page of a lowest hierarchy level has been provided to the browser terminal.

The principle of the *Hirayama* reference is not specifically interested in efficiencies at the electronic level provider, but is rather interested in an anonymous capacity to search web pages without permitting an electronic catalog provider to record or chart the usage of the catalog by such an anonymous user. A user only provides information when it exercises a CALL ME button with an inquiry, and at that time only the inquiry is basically provided.
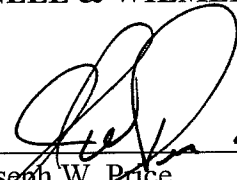
This teaches away from the advantages of the present invention so that the cost of such an anonymous browsing may be a less efficient response from the electronic catalog provider. Thus, competing purposes are at issue and our invention would not be taught, suggested nor capable of being utilized whether combined with the *Hirayama* reference alone or even if combined with the *Fushimi et al.* catalog aggregator.

It is respectfully submitted that applicant has narrowed the issues by illustrating the advantages of the present invention.

If the Examiner believes that a telephone interview will help further the prosecution of this case, the undersigned attorney can be contacted at the listed telephone number.

Very truly yours,

SNELL & WILMER L.L.P.

Joseph W. Price
Registration No. 25,124
600 Anton Boulevard, Suite 1400
Costa Mesa, California 92626-7689
Telephone: (714) 427-7420
Facsimile: (714) 427-7799